

REMARKS

In the Final Office Action,¹ the Examiner:

rejected claims 1-42 and 44² under 35 U.S.C. § 102(b) as anticipated by U.S. Patent Publication No. 2005/0137901 to Siegel ("Siegel"); and

rejected claim 43 under 35 U.S.C. § 103(a) as unpatentable over Siegel in view of U.S. Publication No. 2001/0032143 to Haseltine ("Haseltine").

Claims 1, 8, 12, 18, 25, 29, 34, 36, and 44 are amended by this reply. No new matter is added. Claims 1-44 are pending.

Applicant respectfully traverses the rejection of claims 1-42 and 44 under 35 U.S.C. §102(b) as anticipated by Siegel.

In order to properly establish that Siegel anticipates Applicant's claimed invention under 35 U.S.C. § 102(b), each and every element of each of the claims in issue must be found, either expressly described or under principles of inherency, in a single reference. Furthermore, "[t]he identical invention must be shown in as complete detail as is contained in the ... claim." See M.P.E.P. § 2131, quoting *Richardson v. Suzuki Motor Co.*, 868 F.2d 1126, 1236, 9 U.S.P.Q.2d 1913, 1920 (Fed. Cir. 1989) (emphasis added).

Claim 1 recites "inspecting the product return to determine a disposition decision for the product return, the disposition decision reflecting the results of the inspection, identifying an activity to be performed for the product, and indicating to a first computer

¹ The Office Action contains statements reflecting characterizations of the related art and the claims. Regardless of whether any such statement is identified herein, Applicant declines to automatically subscribe to any statement of characterization in the Office Action.

² The Office Action states on page 2 that only claims 1-42 are rejected under 35 U.S.C. § 102(b). Since, however, an explanation for the rejection of claim 44 is provided in the same section as the explanation for the rejection of claims 1-42, Applicant assumes that claim 44 is also rejected under 35 U.S.C. § 102(b).

based management system the activity to be performed for the product.” Siegel does not disclose or even suggest at least this element of claim 1.

Siegel states “[u]pon inspection of the product for return, whether performed by the consumer, the local return agent or the shipping agent, a determination is preferably made regarding the eligibility of the product return based on the product return guidelines available in return guidelines database 216 or in a database accessible via communications link 230. Such an eligibility determination is preferably made at 445. Should the product desired to be returned by the consumer be deemed ineligible or non-returnable, the consumer is preferably notified and the product is returned to the consumer where appropriate, as indicated in 450. Subsequently method 100 preferably ends at 455. Should the consumer's product be determined eligible for return, method 100 preferably proceeds to step 120 where collection of products to be returned may be effected.” Siegel paragraph [0038].

Neither this portion, nor any other, of Siegel discloses or suggests that a “disposition decision . . . identify[es] an activity to be performed for the product and indicat[es] to a first computer based management system the activity to be performed for the product.” Siegel only discloses that a “product for returned is “inspected” and that a “determination is . . . made regarding the eligibility of the product for return” (emphasis added). Whether or not the product is “eligible” for return does not constitute inherent or explicit disclosure of an “activity to be performed for the product” much less “indicating to a first computer based management system the activity to be performed for the product.” Inasmuch as Siegel fails to disclose, or even suggest, at least this feature of claim 1, the rejection is improper and should be withdrawn.

Notwithstanding the above discussion, the rejection of, for example, claim 1 is improper for at least the following separate and distinct reason. Claim 1 recites “communicating the captured disposition decision from the computer based first management system to a computer based second management system, the computer based second management system performing at least one process related to the entity that returned the product return, and determining the at least one process to be performed depending on the activity identified by the disposition decision.” Siegel does not disclose or even suggest this element of claim 1.

The Office Action alleges that the “abstract [of Siegel] discusses crediting the customer’s account in response to disposition.” Office Action p. 2. This allegation, however, is contrary to the recitations of the claim.

Specifically, claim 1 “identifies an activity to be performed” by a “first computer based management system,” and in response, the “second management system performs a “process related to an entity that returned the product return and determining the at least one process to be performed depending on the activity identified by the disposition decision.” Siegel allegedly discloses “crediting the customer’s account in response to disposition” (Office Action p. 2.), but “crediting the customer’s account” in response to a “**disposition**” is not performing a process depending on the “activity,” as recited in claim 1.

Therefore, the rejection of claim 1 is improper. Since the Office Action has not satisfied its burden to show each and every element of the claim in issue disclosed in the Siegel reference, the rejection of claim 1 should be withdrawn.

For at least the above reasons, independent claim 1 is not anticipated by Siegel.

Claims 2-7 are allowable for at least the reason that they depend from allowable claim 1. Independent claims 8, 12, 18, 25, 29, 34, and 44, although of a different scope, include recitations similar to those discussed above in relation to independent claim 1 and are not anticipated by Siegel for reasons at least similar to those discussed above with respect to claim 1. Claims 9-11, 13-17, 19-24, 26-28, 30-33, and 35-42 are allowable for at least the reason that they depend from one of the allowable independent claims. Therefore, the Examiner should withdraw the rejection of claims 1-42 and 44 under 35 U.S.C. § 102(b).

Claim 43 depends from allowable independent claim 34 and therefore incorporates every element of claim 34. Since claim 34 is allowable, claim 43 is allowable for at least the same reasons as claim 34 inasmuch as Haseltine does not remedy the above discussed deficiencies of the independent claim. Accordingly, a *prima facie* case of obviousness has not been established with respect to claim 43, and the rejection under 35 U.S.C. § 103(a) must be withdrawn.

CONCLUSION

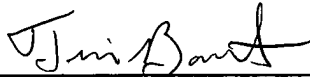
In view of the foregoing, Applicant respectfully requests reconsideration and reexamination of this application and the timely allowance of the pending claims.

Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

FINNEGAN, HENDERSON, FARABOW,
GARRETT & DUNNER, L.L.P.

Dated: March 8, 2010

By: 

Travis R. Banta
Reg. No. 60,498
Telephone: 202-408-4000